

**AMENDMENTS TO THE DRAWINGS:**

This amendment changes reference numeral "12" in Figures 2, 5, and 6 to reference numeral "19."

Replacement drawing sheets containing these amendments to Figures 2, 5, and 6 are attached to this paper.

**REMARKS**

In the last Office Action<sup>1</sup>, the Examiner withdrew the previous rejections of claims 6 and 8 under 35 U.S.C. § 112, second paragraph, and again rejected claims 1-4, 6, and 7 under 35 U.S.C. § 103(a) as being unpatentable over Japanese patent application publication number 08-293159 to Matsumoto et al. ("Matsumoto") in view of U.S. Patent No. 6,748,085 to Yang ("Yang").

Applicant notes that the Office Action Summary lists claim 8 as being rejected. However, the Examiner withdrew the previous rejection of claim 8 under 35 U.S.C. § 112, second paragraph, and did not issue a new rejection of claim 8. Therefore, Applicant understands the current status of claim 8 is allowed. If this understanding is not correct, Applicant respectfully requests clarification of the status of claim 8. See M.P.E.P. § 707.07(j).(II) (8th ed., rev. 4, Oct. 2005).

By this amendment, Applicant has amended the drawings. Claims 1-4 and 6-8 are pending. Applicant respectfully traverses the above rejections and objections for the reasons that follow.

**I. Objections to Drawings**

By this amendment Applicant has amended the drawings to identify the microphone power supply with reference numeral "19" instead of reference numeral "12," in accordance with the Examiner's recommendation. Accordingly, Applicant respectfully requests withdrawal of the objection to the drawings.

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<sup>1</sup> The Office Action contains statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

## II. Claim Rejections

### A. Examiner's Application of In re Keller to Lack of Motivation to Combine Issue was Inapposite

In the Response to Arguments section of the Office Action, the Examiner observed that "the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art." See Office Action, page 3 (citing In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981)).

Applicant does not dispute the Examiner's observations. Instead, Applicant maintains that the combined teachings of the references themselves would not have suggested to one of ordinary skill in the art that the claimed combination be made.

Therefore, Applicant respectfully submits that the application of In re Keller to the "lack of motivation" issues discussed in Applicant's Reply to Office Action filed on February 3, 2006 (Applicant's previous Reply), was inapposite. Should the Examiner continue to rely on In re Keller in responding to Applicant's reasoning, Applicant respectfully requests that the Examiner explain in greater detail the relevance of In re Keller to the lack of motivation issues discussed below and in Applicant's previous Reply.

### B. Rejection of Claims 1-4, 6, and 7 Should be Withdrawn

Claims 1-4, 6, and 7 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Matsumoto in view of Yang. Applicant respectfully traverses the

rejection for at least the reason that there is a lack of motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention.

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), each of three requirements must be met. First, all the claim limitations must be taught or suggested by the prior art. See M.P.E.P. § 2143.03 (8th ed., rev. 4, Oct. 2005). Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the references in a manner resulting in the claimed invention. Third, a reasonable expectation of success must exist. Moreover, each of these requirements must “be found in the prior art, not in applicant’s disclosure.” M.P.E.P. § 2143 (8th ed., rev. 4, Oct. 2005).

### **1. Claims 1-4 and 7**

Claim 1 recites, among other things: “a detection section which detects whether or not a voltage of one of the right and left signal channel terminals is substantially equal to a ground voltage, and provides a detection result.”

In the last Office Action, the Examiner correctly observed that “Matsumoto fails to disclose . . . detecting whether or not a voltage is equal to a ground voltage.” See Office Action, page 6. The Examiner maintained, however, that Yang teaches this feature and that it would have been obvious to “modify Matsumoto so that the detection [section] detects whether or not a voltage is equal to a reference voltage as taught by Yang in order to identify whether a stereo or mono device is connected.” See Office Action, page 7 (citing Yang, col. 4, lines 65-67). Moreover, in responding to Applicant’s

reasoning, the Examiner alleged that “[i]t is clear . . . Yang supplies motivation [to modify Matsumoto] . . . , which is to identify whether a stereo or mono device is connected.” Id., page 4. Applicant respectfully disagrees for the following two reasons.

First, Matsumoto describes a recorder that identifies whether a stereo or mono device is connected to a connection jack. See Matsumoto, Abstract. Therefore, contrary to the Examiner’s allegation, one of ordinary skill in the art would never look to or rely on Yang for features that “identify whether a stereo or mono device is connected.” Such features would be redundant with corresponding features already described in Matsumoto.

Second, if Yang were to be combined with Matsumoto as proposed by the Examiner, certain advantageous features described in Matsumoto could not be achieved. See M.P.E.P. § 2145.(X).(D).(2) (8th ed., rev. 4, Oct. 2005) (“It is improper to combine references where the references teach away from their combination.”) (citing In re Grasselli, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)).

For example, the detection circuit in Matsumoto includes voltage divider circuits formed by R1, R2, R3, and R4 (see Matsumoto, Fig. 1) to support a dynamic microphone (i.e., a microphone having its own power source). See Matsumoto, paragraph 14. In order to modify Matsumoto as proposed by the Examiner, the voltage divider circuits of Matsumoto would necessarily be excluded, as shown in the detection section of Yang. See Fig. 3 of Yang (in particular, the non voltage-dividing line connecting socket 106 to low pass filter 116). Because combining Matsumoto with Yang would necessarily eliminate the dynamic microphone feature of Matsumoto, the references teach away from their combination. Therefore, a person of ordinary skill

in the art would not have been motivated to combine Matsumoto with Yang as proposed by the Examiner. Matsumoto and Yang thus fail to establish a *prima facie* case of obviousness.

Accordingly, the rejection of claim 1 under 35 U.S.C. § 103(a) should be withdrawn. Applicant further submits that claims 2-4 and 7 each depend from allowable independent claim 1 and are therefore also allowable.

## 2. Claim 6

Independent claim 6, although of different scope, recites language similar to that of claim 1, discussed above. Therefore, as discussed above with respect to claim 1, there would have been no motivation for a person of ordinary skill in the art to have combined Matsumoto with Yang in a manner resulting in the claimed invention.

Moreover, no *prima facie* case of obviousness has been established with respect to claim 6 for at least the reason that the references, taken alone or in combination, do not teach or suggest each and every element recited in claim 6. For example, claim 6 recites, among other things: “a recording section which uses [an] A/D converter to convert right and left audio signals amplified by the microphone amplifiers into digital signals [and] . . . a detection section which uses the A/D converter to convert a voltage of one of the right and left signal channel terminals into voltage data.”

In the Office Action, the Examiner identified a controller 18 (including A/D input ports 18a and 18b) in Matsumoto as corresponding to the claimed A/D converter. Controller 18 detects left and right terminal voltages (see Matsumoto, paragraphs 27-29) but does not “convert right and left audio signals amplified by the microphone amplifiers into digital signals,” as required by claim 6. Instead, conversion of analog

voice signals to digital voice data is carried out by a second set of A/D converters 6L and 6R. See id., paragraphs 16-18.

In contrast, claim 6 recites an A/D converter that is both (1) used by a recording section “to convert right and left audio signals amplified by the microphone amplifiers into digital signals” and (2) used by a detection section to “[detect] whether or not the voltage of one of the terminals is substantially equal to a ground voltage.” Yang fails to overcome the deficiency of Matsumoto because Yang similarly discloses, in Fig. 3, a first A/D converter in a detection circuit (microcontroller 118) and a second A/D converter in an audio signal processor 112. See Yang, col. 4, lines 8-52. Therefore, Matsumoto and Yang, taken alone or in combination, do not teach or suggest each and every element recited in the claims. For at least this additional reason, Matsumoto and Yang fail to establish a *prima facie* case of obviousness.

Accordingly, Applicant respectfully submits that the rejection of claim 6 under 35 U.S.C. § 103(a) should also be withdrawn.

### **Conclusion**

In view of the foregoing remarks, Applicant respectfully requests reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

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Respectfully submitted,

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